

Appln. No.: 10/089,822
Amendment Dated May 10, 2006
Reply to Office Action of February 10, 2006

GRY-106US

Remarks/Arguments:**Premature Final Rejection:**

This Action is a Final Office Action. Applicant respectfully asserts that it is a premature Final Rejection and, so, should be treated as a non-final rejection. Pursuant to MPEP § 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). ...

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP §904 *et seq.* For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.

In an Office Action dated May 27, 2005, claims 1-12 were rejected under 35 U.S.C. § 112, second paragraph. In addition, claims 1, 5 and 9 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Sprague et al. The remaining claims were objected to only as being dependent on rejected base claims. Thus, the previous Examiner indicated that these claims included patentable subject matter.

In response to this rejection, Applicant amended the claims to overcome the rejections under 35 U.S.C. § 112, second paragraph and amended claim 1 to include a limitation from claim 2, namely to require that the process includes the steps of formatting each unit of the retrieved information on a single sheet of paper in the form of a four page booklet. Because the rejections under 35 U.S.C. § 112 were "of limitations which should reasonably have been expected to be claimed" and because the grounds for rejecting at least claims 2-4, 6-8 and 10-12 are not necessitated by Applicant's amendment, the Office Action dated February 10, 2006 should not have been final. Applicant respectfully requests that this Action be made non-final and that the amendments set forth above be entered and considered as if the Action were a non-final Action.

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Amendments to the Specification

In the Office Action, the title was objected to as being non-descriptive. It appears that this is based on a misunderstanding. In the Office Action it is stated, "Examiner is unable to locate where the claimed invention mentions anything about improving the print quality of documents." The title of the invention, however was "PROCESS AND METHOD FOR DISTRIBUTING INFORMATION ORIGINATING FROM A DATABASE." This title has nothing to do with "print quality." Nonetheless, even though it is not necessary to do so, Applicant has amended the title as suggested in the Office Action.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-12 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Faros et al. and Spector. Applicant respectfully asserts that claims 1-12 are not subject to rejection under 35 U.S.C. § 103(a) in view of Faros et al. and Spector because neither of these references either alone or in combination disclose or suggest, "breaking down the information contained in the database into units each with a single predetermined number of symbols," as required by claim 1, claims 5 and 9 include similar recitations. Basis for this amendment may be found in the original claims 1, 5 and 9 and in the specification at paragraph [0018]. As stated in this paragraph, "the information is broken down into units each with a predetermined number of symbols." The article "a" in front of the "predetermined number of symbols" indicates a singular predetermined number of symbols. Accordingly, this limitation requires units of information to be equal in size, each unit having a single predetermined number of symbols.

Faros et al. concerns a printing system that enables the creation of a variety of printed products. In the Office Action, it is asserted that Faros et al. discloses "breaking down the information contained in the database into units, each comprising a predetermined number of symbols (Faros, Fig. 4, 105, 107, 108 109)." Applicant respectfully disagrees with this assertion. Faros et al., at column 4, lines 37-58 describes these items simply as computerized forms which may be modified by a user to create various documents. There is no indication anywhere in Faros et al. that these files are or include "units each with a single predetermined number of symbols." Indeed, at column 4, lines 27-30, Faros indicates that, "[s]uch forms include forms for the generation of business cards, stationery, self-adhesive notepads such as

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Post-It® Notes, certificates, announcements, greeting cards and postcards.” These forms are obviously quite different and could not be produced if each of the units had a single predetermined number of characters.

This step provides the subject invention with an advantage of simplicity. The purpose of the subject invention is to print out small pamphlets, in the form of a four-page booklet, formed from a single sheet of paper. In order to ensure that each of the units may be printed on a single sheet of paper in the form of a four-page booklet, the subject invention first partitions the data in the database into units of equal size, that is to say, the number of characters that can be printed on a single sheet of paper in the form of a four-page booklet.

Spector was cited as disclosing a greeting card in which a sheet of paper is divided into four frames, A, B, C and D. Spector, however, does not disclose or suggest printing on all four frames. Instead, Spector discloses printing only on frames B and C. (See Figs. 1 and 7). Furthermore, Spector does not disclose or suggest that information in a database is broken down into units each with a single predetermined number of characters, and, thus, does not provide the material that is missing from Faros et al.

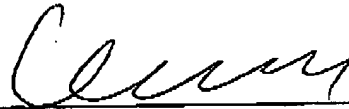
Because claims 1, 5 and 9 include a limitation that is not found in Faros et al. or in Spector, these claims are not subject to rejection under 35 U.S.C. § 103(a) in view of Faros et al. and Spector. Claims 2-4 depend from claim 1, claims 6-8 depend from claim 5 and claims 10-12 depend from claim 9. Accordingly, these claims are not subject to rejection under 35 U.S.C. § 103(a) in view of Faros et al. and Spector for at least the same reasons as claims 1, 5 and 9.

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In view of the foregoing amendments and remarks, Applicants request that the Examiner reconsider and withdraw the objection to the title and the rejection of claims 1-12.

Respectfully submitted,



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May 10, 2006



Patricia C. Boccella

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